REMARKS

Claims 1-4, 6-15, 26-29, 31-34, 54, 65, and 66 are pending and have been examined. Applicant appreciates the examiner's statement that claim 66 is allowable if rewritten in independent form. The present office action is addressed as follows.

Claim 65 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Givens (U.S. Patent No. 6,681,530). Applicant respectfully traverses this rejection.

The examiner considers the shape of the diverter body as recited in claim 65 to be an intended use expression, and not a limitation of the claim. However, the limitation regarding the diverter body should be interpreted to limit the claim by identifying a shape of the diverter body. That is, claim 65 recites that the diverter body is "shaped to surround and fit closely to a generally cylindrical post." While this language does provide information as to a use for the diverter, it also identifies the structural shape of the diverter body by defining it with respect to a generally cylindrical post. Specifically, the diverter body must be shaped so that it fits closely with a cylindrical post, which is a positive structural limitation recited in the claim. The shape recited in the claim is no more an intended use than the roundness of a tire. No proper interpretation of claim 65 can ignore the shape that is positively defined with reference to the generally cylindrical post.

The shape defined in claim 65 is also illustrated in the specification, which may aid the Examiner in interpreting the shape defined in claim 65. As shown in Fig. 9A, the vertical portion 70 can surround and fit closely to a generally cylindrical post unit 66. That is, the generally cylindrical structure of the vertical portion 70 allows the diverter to fit closely to a generally cylindrical post 66.

In contrast, Givens discloses pre-formed flashings made up of generally planar panels (See Givens, col. 6, lns. 6-9). The examiner cites Givens as disclosing a flashing that includes four generally planar panels (vertical panels 116 and 117, angled panels 119 and 121). However, these generally planar panels lack the shape necessary to fit closely around a generally cylindrical pole, as recited in claim 65. Accordingly, Givens fails to disclose the

features of claim 65. For this reason, applicant requests withdrawal of the rejection of claim 65.

Claims 1-4, 6-15, 26-29, 31-34, and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Givens. Applicant respectfully traverses this rejection.

Regarding independent claims 1 and 54, the examiner asserts that setting the second predetermined width of the angled section to be substantially larger that the first predetermined width of the vertical section is an obvious design choice to one of ordinary skill in the art. "Design choice" as it relates to changes in size or proportion can be used to reject claims but is appropriate only where "the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device". MPEP § 2144.04(IV)(A)(citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). If a different function is accomplished, mere assertion of "design choice" does not establish a *prima facie* case of obviousness. Further, the prior art must provide a teaching or suggestion that would lead one of ordinary skill in the art to modify the disclosed device for a feature to be considered a matter of "design choice" (See *In re Chu*, 66 F.3d 292, 36 U.S.P.Q.2d 1089, (Fed Cir 1995)). The examiner asserts that one would be motivated to alter the teachings of Givens to cover a larger area. However, the stated objects of Givens are merely to provide flashings fitting various surface intersections (See Givens, col. 1, line 61 - col. 2, line 6) applied in roofing. Givens is not concerned with covering large areas, as the examiner appears to assert, and is not concerned with foundation issues. Accordingly, one of skill in the art would not be motivated to alter Givens as suggested by the examiner, based on the teachings of Givens. For this reason, applicants assert that it would not be a matter of design choice to modify Givens in a way that would result in a structure similar tot hat of the present invention.

The examiner also asserts that applicant has not disclosed the criticality of setting the second predetermined width of the angled section to be substantially larger that the first predetermined width of the vertical section. In response, applicants assert that the

wider angled section is necessary because a relatively wider angled section allows water to be diverted further away from the foundation (See applicants' Specification, p. 4, lns. 16-17). As stated, conventional methods for "damproofing" a foundation include coating foundation walls with bitumen, placing plastic beneath a concrete floor slab, and installing a sump pump to collect and discharge water that accumulates in soil beneath the floor slab. However, these damproofing methods are ineffective when soil surrounding the foundation is saturated (p. 2, lns. 11-16). The purpose of the diverters is to divert water away from a building foundation, which helps to prevent the soil surrounding the foundation from saturating, reducing the possibility of water damage (See p. 7, lns. 11-13; p. 9, lns. 17-21). To accomplish this goal, the water must be moved a distance sufficient to ensure that the soil surrounding the foundation is not saturated. Accordingly, it is important that the angled section have a relatively large width for diverting water flow.

Further, it is desirable for a diverter to have a relatively low profile on the building it protects, and to be able to attach the diverter to an existing building while disrupting a minimal amount of wall covering. This is accomplished in the present invention by using a diverter with a vertical section that has a relatively small width. For example, the ratio of vertical section width to angled section width is preferably between about 1:1 and 1:10. This ratio helps to ensure that water is properly diverted, while the diverter maintains a relatively low profile.

Givens shows, in Fig. 8, a flashing made up of vertical planar sections 116 and 117, and angled planar sections 119 and 121. However, the reference teaches that a flashing has a vertical height T of 8 inches, and a horizontal distance X of 4 inches (See Givens, col. 5, lns. 53-56; col. 7, lns. 23-25). That is, Givens teaches that the vertical height of a flashing is greater than the horizontal distance covered by the flashing. Moreover, Givens teaches that the height of the flashing should be chosen so that most of the vertical section is covered by material applied to the wall to which the flashing is attached (col. 5, lns. 53-55).

Thus, since setting the second predetermined width of the angled section to be substantially larger that the first predetermined width of the vertical section is not merely a

design decision, is critical to the claimed invention, and is not disclosed by the cited prior art, applicant requests withdrawal of the rejection of independent claims 1 and 54, and their associated dependent claims.

Regarding claim 26, the examiner asserts that it would have been obvious to create a diverter system including first, second, and third flashings because duplication of working parts requires only routine skill in the art. However, claim 26 recites three distinct diverter bodies having different shapes and structures (i.e., a first diverter body is shaped to fit an outside corner, a second diverter body is shaped to fit a planar surface, and a third diverter body is shaped to fit an inside corner). Further, as discussed above with regard to claim 65, the way each diverter body is shaped represents more than mere intended use. Rather, the way each diverter body is shaped defines the structure of that diverter body. Thus, more than mere duplication of parts is required to construct the three diverter bodies.

Moreover, Givens fails to disclose a third unibody diverter body shaped to fit an inside corner, as recited in claim 26. That is, while the reference shows, at Fig. 8, a one-piece corner flashing mounted at the junction of two vertical, perpendicular walls, the walls form an outside corner, as defined by the present specification. Thus, since more than mere duplication of parts is required by the limitations recited in claim 26, and because Givens fails to disclose at least a third unibody diverter body, applicant requests withdrawal of the rejection of claim 26 and its associated dependent claims.

For all the foregoing reasons, applicant requests reconsideration and allowance of the instant application. Should the examiner believe that a telephone conference would aid in the prosecution of the application, the examiner is invited to contact the undersigned attorney at the below-listed number.

Respectfully submitted,

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